

REMARKS

Claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 101, 102, 104-120, 138, 139, 141-157 and 226-228 are pending.

Claims 1-225 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of US Patent 7,113,853 (“the ‘853 patent”). Initially, applicant notes that this rejection is improper for two reasons. First, it includes claims that are not pending in this application. For example, claims 3 and 11-14 are no longer pending in this application. Also, this rejection does not indicate which claims in the ‘853 patent render specific claims in this application unpatentable. Since a double patenting rejection is based on claims of the previous patent, such claims must be asserted in the rejection.

The Examiner asserts that the claims are not patentably distinct from one another because “they are both drawn toward checking the title history of a vehicle that are used to check previous owners, while the intended use is different, all the same information is collected and the uses for the collected information are deemed to be obvious variants.” As noted in the previous response, this position is without legal or factual basis.

The ‘853 patent is directed to determining whether a vehicle has reliability issues, such as vehicle recalls or manufacturer buybacks, and/or passed import inspection. Since the analysis of the vehicle history records is completely different and, in the ‘853 patent, the records are not used to check previous owners, the pending claims are patentably distinct. The express functions of the steps recited in method claims must be given weight. The Examiner admits that the claimed method steps are different than the patented method steps but dismisses the different function as “intended use.” It is improper to disregard language recited in the claims. *Application of Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970) (“All words in a claim must be

considered in judging the patentability of that claim against the prior art.”); *In re Lowry*, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994) (“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.”); MPEP §§706.02(j); 2142; 2143.03. In setting forth a prima facie case, the examiner may not opportunistically disregard certain claim language; rather, “[e]very word in a claim must be considered in judging the patentability of a claim against the prior art.” See *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Finally, the Examiner concludes that the “uses for the collected information are deemed to be obvious variants.” However, the examiner fails to provide any rationale for this conclusion other than the mere conclusory comment. In fact, determining ownership and determining reliability are entirely different determinations. The fact that some of the same data records can be processed, albeit in very different ways, for each determination does not render the claimed method, which recites distinct function, obvious. As stated in MPEP Section 2142

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

The Examiner has failed to offer any acceptable rationale for the conclusion of obviousness. The obviousness double patenting rejection should be withdrawn.

Claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 138, 139, 141-157, and 226-228 stand rejected based on 35 U.S.C. § 101 as being directed to non-statutory subject matter.

With respect to claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, and 226-228, the examiner takes the position that the steps recite “merely a trivial use of the computer” and notes that the determining step could be accomplished by “looking at data on a screen”. Again, the Examiner seems to ignore legal precedent and Patent Office practice.

For example, independent claim 1 recites that the steps of “identifying a target record ...”, and “identifying whether a trigger record ...” are accomplished by computing devices. The Examiner’s conclusion of triviality is incorrect. The identification of target records and trigger event records is an important aspect of the claims and the determining step cannot be accomplished without such identification. During a telephone communication on July 30, 2009 with the undersigned, the Examiner indicated that such claims would avoid the rejection based on 35 U.S.C. § 101.

Additionally, the conclusion that the determining can be accomplished by viewing a screen is incorrect and irrelevant. First, the determining step requires that the trigger record be processed by a computing device. Second, the determining step has expressly recited function that is more than just display of an image.

Also, the Examiner concludes that the computer readable medium recited in claims 138, 139, and 141-157 could “merely be a signal”. The claims cannot be merely a signal because they are directed to instructions recorded on computer readable media. Applicant notes that MPEP 2106.01 states, “When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” Also, claim 138 has been amended to expressly recite that the instructions are “computer executable”. Accordingly, this rejection should be withdrawn.

Claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 138, 139, 141-157, and 226-228 stand rejected based on 35 U.S.C. § 103(a) as being obvious in view of Barnett (U.S. Patent No. 4,989,144).

The Examiner submits that Barnett teaches all the elements of each of the independent claims, except for "using the data to adjust ownership." The Examiner further submits that Barnett discusses salvage titles and that "it is old and well known in the art that a one-owner vehicle is more prized than one which has had multiple owners (for instance ads that claim "Clean-one-owner!")), and concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention "to use the method and system taught by Barnett for adjusting the price of vehicles as a vehicle sold as 'salvage' is worth much less than one without, a vehicle with 'true mileage unknown' (which would be recorded at a sale) is also worth less and further, a one owner vehicle can be worth more if only by perception." Applicants disagree.

Barnett describes a system and method for determining whether a discrepancy, such as a prior salvage title, inconsistent odometer readings, duplicate title, title with unknown mileage, etc., exists. Barnett does not describe determining if an ownership transfer has occurred or determining a price adjustment and/or value of the vehicle based on the ownership transfer. Thus, the Examiner has not pointed to a teaching in Barnett for all of the limitations of the independent claims. Furthermore, the Examiner has failed to provide an adequate reason for modifying Barnett - it is unclear to the Applicants how ads that claim "Clean-one-owner!" would lead one of skill in the art to the invention which determines if apparent ownership transfer are likely to be actual ownership transfers.

Moreover, one of skill in the art would not have a reasonable expectation of success based on this combination. The cited art fails to provide a discussion of how the likelihood of

an ownership transfer is determined from ownership records, how a price adjustment and/or value of the vehicle is determined using that information, and why this analysis has not been done accurately in the past. In contrast, the present specification provides such a description. In particular, paragraph [0051] states: "... For example, situations involving duplicate titles, lien discharges, title error correction and owner relation/moving, result in new title/registration records where in fact no transfer in vehicle ownership has occurred. Therefore, simple counting of the title/registration records would not ensure accurate determination of the number of owners for a particular vehicle." That is, in the prior art, systems that simply counted the title/registration records resulted in errors. In the present specification, on the other hand, a detailed description of how the determination is made follows paragraph [0051]. Similarly, a very detailed description of determining the adjustment or value of the vehicle is described beginning at paragraph [0122].

Further, amended independent claims 1, 78, 101, and 138 each expressly recite the novel use of target records (which are title or registration records,) and trigger event records to determine if a target record is likely to represent an ownership change. The prior art of record fails to teach or suggest the use of trigger event records in the claimed manner. Thus, the cited art fails to teach or suggest all of the limitations of the independent claims. The dependent claims depend, directly or indirectly, from one of the foregoing independent claims. This rejection should also be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 50-3557. Applicants petition for any extension of time that may be necessary to maintain this application in force. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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